

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-25 are currently pending in this application; Claims 1, 16, 18, 20, 22, and 24 are amended by the present Amendment.

In the outstanding Office Action, Claims 1-9 and 13-25 were rejected under 35 U.S.C. §102(e) as anticipated by Anderson et al. (U.S. Patent Publication No. 2004/0039750 A1); dependent Claim 12 is rejected under 35 U.S.C. §103(a) as unpatentable over Anderson et al. in view of Igarashi et al. (U.S. Patent No. 6,747,680); and Claims 10 and 11 were objected to for depending from a rejected base claim, but were otherwise indicated as being allowable.

Applicant requests that the Information Disclosure Statements filed on January 21, 2004 and March 24, 2004 be acknowledged on the record in their entirety.

Claims 1, 16, 18, 20, 22, and 24 are amended to recite controlling at least a display of an electronic book with an electronic book behavior specification having a static specification and a dynamic specification. Support for this amendment is found in Applicants' original specification.¹ No new matter is added.

Applicants acknowledge with appreciation the personal interview between the Examiner and Applicants' representative on March 22, 2005. During the interview, the claimed and disclosed inventions were contrasted with Anderson. In particular, Applicants' representative distinguished the self-loading software of Anderson was contrasted with the claimed dynamic specification. The Examiner's attention was also directed to pages 14-16 of Applicants' specification for further discussion of the claimed static and dynamic specification.

¹ Specification, page 16, lines 8-24.

Briefly recapitulating, amended Claim 1 is directed to a method for controlling an electronic book. The method includes controlling at least a display of the electronic book with an electronic book behavior specification. The electronic book behavior specification contains both a static specification and a dynamic specification. The dynamic specification is configured to allow an electronic book behavior to be initiated or modified via a user-initiated command or an automatically-initiated command. A non-limiting example of controlling with a dynamic specification includes automatically flipping a page when a video is completed.

Anderson describes a method for publishing and viewing an electronic book. The method includes generating a publication with software.² Some embodiments of the virtual publication include animated features which may be loopable.³ Animation or pop-ups may be caused to execute or otherwise appear by way of a mouse-click.⁴ However, Anderson does not disclose or suggest two separate book behavior specifications, a static and a dynamic specification. Applicants' submit that the behaviors described in Anderson each correspond to behaviors identified in Applicants' specification⁵ as 'static.' That is, Anderson does not disclose or suggest Applicants' claimed dynamic specification. Furthermore, Anderson does not disclose or suggest Applicants' claimed controlling at least a display with a static and a dynamic specification that includes verifying the status of a first behavior; and causing a second behavior to occur depending on the status of the first behavior.

MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either

² Anderson, paragraph 130.

³ Anderson, paragraphs 99 and 134.

⁴ Anderson, paragraph 109.

⁵ Specification, pages 13-16.

Application No. 10/760,298
Reply to Office Action of September 29, 2004

generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Anderson does not disclose or suggest all the features recited in Claims 1, 16, 18, 20, 22, and 24, Anderson does not anticipate the invention recited in Claims 1, 16, 18, 20, 22, and 24.

Consequently, in view of the above amendments and comments, it is respectfully submitted that the outstanding rejection is traversed and that the pending claims are in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Michael E. Monaco
Registration No. 52,041

I:\ATTY\MM\AMENDMENT\10581\247753US_AM.DOC